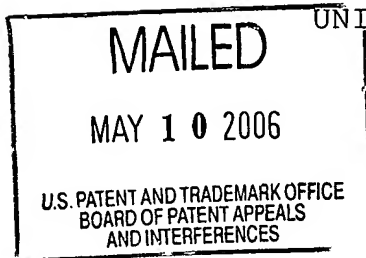


The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MU-III LIM and YUH-GUO PAN

Appeal No. 2006-1158
Application No. 10/052,733

ON BRIEF

Before KIMLIN, GARRIS, and PAK, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claim 1.

The subject matter on appeal is 4-Amino-2-(1-hydroxy-ethyl)-phenol which is said to be useful as an intermediate for oxidative coloring of hair fibers. The sole claim on appeal is reproduced below:

1. 4-Amino-2-(1-hydroxy-ethyl)-phenol

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The following reference is relied upon by the examiner as evidence of obviousness:

Vayssie et al. (Vayssie) 5,073,174 Dec. 17, 1991

Claim 1 is rejected under 35 U.S.C. § 103(a) as being obvious over Vayssie.

We refer to the Brief and to the Answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above-noted rejection.

OPINION

We will sustain this rejection for the reasons well-stated by the examiner in his answer. We add the following comments for emphasis only.

It is undisputed that Vayssie discloses 2-hydroxymethyl-4-aminophenol and 2-(β -hydroxyethyl)-4-aminophenol as precursors for hair dye (e.g., see the abstract and lines 41-42 in column 3) and that these compounds are respectively a one-carbon homolog and a structural isomer of the appellants' claimed compound. It is the examiner's basic position that one having ordinary skill in this art would have been motivated to modify either one of these prior art compounds in such a manner as to obtain a 4-Amino-2-(1-hydroxy-ethyl)-phenol (as here claimed)

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based on a reasonable expectation that the obtained compound would possess the hair dye precursor property of the prior art compounds due to the close structural similarity of the former with the latter.

On the other hand, it is the appellants' fundamental argument that no such motivation or reasonable expectation exists in this case. As support for this argument, the appellants cite In re Grabiak, 769 F.2d 729, 226 USPQ 870 (Fed. Cir. 1985). The appellants' argument is unpersuasive.

Contrary to the appellants' apparent belief, In re Grabiak, id., is inapposite to the factual and legal issues before us on this appeal. Unquestionably more relevant to these issues are: In re Grunwell, 609 F.2d 486, 491, 203 USPQ 1055, 1058 (CCPA 1979); In re Wood, 582 F.2d 638, 641, 199 USPQ 137, 139 (CCPA 1978); In re Wilder, 563 F.2d 457, 460-61, 195 USPQ 426, 429-30 (CCPA 1977); In re Doebel, 461 F.2d 823, 824, 174 USPQ 158, 159 (CCPA 1972); In re Rosselet, 347 F.2d 847, 851, 146 USPQ 183, 185 (CCPA 1965); In re Zickendraht, 319 F.2d 225, 227, 138 USPQ 22, 25 (CCPA 1963); In re Henze, 181 F.2d 196, 201, 85 USPQ 261, 265 (CCPA 1950); and In re Hass, 141 F.2d 122, 125, 60 USPQ 544, 547 (CCPA 1944).


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Based on the above-listed body of decisional precedent, we determine that the examiner has established a prima facie case of obviousness which the appellants have failed to successfully rebut with argument or evidence of nonobviousness. See In re Oetiker, 977 F.2d 1443, 1444-45, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We hereby sustain, therefore, the examiner's § 103 rejection of claim 1 as being unpatentable over Vayssie.


The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED


EDWARD C. KIMLIN)
Administrative Patent Judge)


BRADLEY R. GARRIS) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
INTERFERENCES)


CHUNG K. PAK)
Administrative Patent Judge)

ECK:clm

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